

REMARKS

In the August 9, 2007, Final Office Action¹, the Examiner rejected claims 1-10 and 16-27 under 35 U.S.C § 103(a) as being unpatentable over U.S. Patent No. 6,058,413 to Flores ("Flores") in view of U.S. Published Patent Application No. 2005/0177507 to Bandych et al. ("Bandych"). Claims 1-10 and 16-27 remain pending.

Applicants respectfully traverse the rejection of claims 1-10 and 16-27 under 35 U.S.C § 103(a) as being unpatentable over *Flores* in view of *Bandych* because no *prima facie* case of obviousness has been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01(III) (emphasis in original). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

¹ As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to certain assertions or requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include] [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Here, a *prima facie* case of obviousness has not been established because the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Examiner has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Independent claim 1 recites "[a] method for automatically filing documents relating to business transactions using a computer system" including "reading, by the at least two business applications, the different data areas in the output data record depending on the data requirements of the at least two business applications by referring to the identification code." On page 3 of the Final Office Action, the Examiner asserts that *Bandych* teaches the claimed "output data record" and "reading . . . the output data record." This is not correct.

Bandych is generally directed to "processing transactions between at least one buying company and at least one selling company." (*Bandych*, Abstract). First, "purchase order and receipt data as well as invoice data is extracted[,] . . . validated[,] . . . and then stored into the system." (*Bandych*, ¶ [0124]). Next, "the data is sort[ed] into logical groupings (also referred to herein as segments or

pools) . . . [where] user defined parameters 204 are used to determine the appropriate type of segmentation (or pooling) to perform on the extracted invoice/receipt data . . . so as to develop a tree-like hierarchy of segments to be searched by the automated and manual matching process." (*Bandych*, ¶ [0125]). Furthermore, a "match strategy is then applied to the segmented (pooled) transaction data in order to automatically match invoices to receipt data." (*Bandych*, ¶ [0128]). If there is a match between invoice and receipt data, a unique match identifier (Match ID) "is associated with all of the documents that [are] related to the particular match, such as the invoice and receipt documents, and also the purchase order documents." (*Bandych*, ¶ 0132). Finally, "[t]he associated match data (along with the Match ID) is then stored in the system database in step 238, and the match data is forwarded to the customer's accounting system for appropriate payment, etc." (*Id.*)

The Examiner appears to allege that *Bandych*'s match data correlates to the claimed "output data record." However, this is incorrect because *Bandych*'s match data does not have "different data areas" as required by the "output data record" recited in claim 1. Instead, "documents related to that transaction are stored as part of the collaborative data set." (*Bandych*, Abstract). These "documents . . . as part of the collaborative data set" do not teach or suggest "different data areas" required by claim 1 because there is no "reading . . . the different data areas in the output data record depending on the data requirements of the at least two business applications," as recited in claim 1.

Moreover, there is no "reading, by the at least two business applications, the different data areas in the output data record," as required by claim 1 (emphasis added).

Instead, for a particular match, “the match data is forwarded to the customer’s accounting system.” (*Bandych*, ¶ [0132]). *Bandych*’s customer accounting system does not constitute or suggest “at least two business applications,” as required by claim 1 (emphasis added).

Therefore, *Bandych* fails to teach or suggest “reading, by the at least two business applications, the different data areas in the output data record depending on the data requirements of the at least two business applications by referring to the identification code,” as recited by claim 1.

In view of the mischaracterization of the prior art set forth above, the Office Action has failed to properly determine the scope and content of the prior art and to properly ascertain the differences between the prior art and the claimed invention. Thus, the Office Action has failed to clearly articulate a reason why the claims would have been obvious to one of ordinary skill, in view of the prior art. Accordingly, no *prima facie* case of obviousness has been established, and the Examiner should withdraw the rejection of independent claim 1 under 35 U.S.C § 103(a).

Independent claim 10 and 24, while differing in scope from claim 1, comprise similar recitations as claim 1. Accordingly, the Examiner should withdraw the rejection of claims 10 and 24 at least due to the reasons discussed previously.

Claims 2-9, 16-23, and 25-27 depend from one of independent claims 1, 10, and 24. Accordingly, the Examiner should withdraw the rejection of claims 2-9, 16-23, and 25-27 at least due to their dependence.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are neither anticipated nor rendered obvious in view of the references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 1, 2007

By: Robert Elman #27432
C. Gregory Gramenopoulos
for Reg. No. 36,532